

### **REMARKS**

Claims 1-5, 7-8, 10-17, 19-32, 34-40, 42-49, 51-61, 63-69, 71-78, 80-87 and 89-100, are pending herein.

Claims 1-5, 7-8, 10-17, 19-26, 95 and 98-100 were rejected under 35 U.S.C. § 103(a) over Christensen (U.S. Patent Application Publication No. US 2003/0216815 A1) and Fuchs et al. (U.S. Patent 6,527,972) and Claims 27-32, 34-40, 42-49, 51-61, 63-69, 71-78, 89-94, 96 and 97 were rejected under 35 U.S.C. §103(a) over Demon (U.S. Patent 5,813,142) and Christensen ('815) and Fuchs et al. ('972).

As noted previously in the Amendment filed on May 20, 2005, the Christensen ('815) reference does not teach or suggest the aspect of a magnetically responsive fluid that includes core particles of a magnetic material, wherein core particles include first and second successive coatings. Likewise, as previously noted in the same Amendment, Demon also lacks in teaching or suggesting the use of the claimed fluid. In the present Office Action, the Examiner has now cited Fuchs reference for the teaching of providing bilayers or multiple layers of coatings on particles and for the use of the claimed materials and size of the particles, as claimed.

Fuchs et al. is directed to magnetorheological polymer gels for use in engine mounts, shock absorbers, seat dampers, exercise equipment, aspherical optical

lens polishing, vibration control and damping, earthquake resistance structures, etc. (see Column 1, lines 12-40 of Fuchs et al.). To the contrary, the present invention is directed to a cushioning device for a footwear. It is, therefore, respectfully submitted that the Fuchs et al. reference is directed to a completely different field of endeavor or purpose and is therefore non-analogous art.

The Federal Circuit has clarified the criteria for determining whether a reference is reasonably pertinent to the particular problem with which the invention is involved, and has stated that

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem.... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem.... [I]f it is directed to a different purpose, the inventor would accordingly have less motivation or occasion to consider it. (emphasis added)

*In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

It is submitted that an artisan working in the footwear art would be concerned with a completely different set of problems than an artisan working in, for example, automotive, exercise equipment, or optical lens polishing industry. The purpose and problems facing the two artisans would be completely different thereby leading to completely different results.

It is further respectfully submitted that no reason, suggestion, or motivation has been provided in the cited references to combine in the manner suggested in

the Office Action. More specifically, why would one of ordinary skill in the art select the magnetorheological polymer gel of Fuchs et al., which has a higher viscosity than a fluid, and combine it with Christensen's liner for prosthetic socket has not been pointed out. While Christensen discloses the use of a magneto or electrorheologic fluid generally, why one of ordinary skill in the art would select the coated particles of Fuchs et al., without the benefit of the claimed invention, has not been shown.

The statement in paragraph 2, on page 2, of the Office Action that "[i]t would have been obvious to use the magnetorheologic material taught by Fuchs for the fluid and/or particles in the cushion of Christensen '815 to minimize the variance in force required by the device over a given temperature range, i.e., to reduce the effect of temperature change on the performance of the device." and the statement in paragraph 3, on pages 2-3, of the Office Action that "[i]t would have been obvious to use the magnetorheological material taught by Fuchs for the fluid and/or particles in the cushion of Christensen '815 and to use magnetorheological fluid and systems as taught by Christensen '815 in the shoe of Demon to reduce the moving mechanical elements of the shoe and to make the shoe sole system smaller.", amount to no more than hindsight. As the Federal Circuit has stated:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the

changes espoused by the Examiner and endorsed by the Board.

Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

*In re Fritch*, 972 F.2d 1260, 23 USPQ 1780, 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998)).

In this regard, it is not understood how the coatings on the particles would reduce the effect of temperature change on the performance of the Christensen device. Also, Christensen does not appear to be concerned with the effect of temperature change on the performance of his device. Likewise, it is not understood how using the magnetorheological fluids/material of Christensen or Fuchs would reduce the "the moving mechanical elements" or make the shoe sole system "smaller". Also, Demon does not appear to be concerned with these issues.

Both the suggestion and reasonable expectation of success must be found in prior art, and not the Applicant's disclosure. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531 (Fed. Cir. 1988).

In view of the above, it is respectfully submitted that Christensen ('815), Fuchs (U.S. Patent 6,527,972) and Demon (U.S. Patent 5,813,142) cannot be

legally combined in the manner suggested in the Office Action to render the claimed invention obvious.

### **PROPRIETARY INFORMATION DISCLOSURE STATEMENT**

The Examiner is respectfully requested to acknowledge review of the material submitted via the Proprietary Information Disclosure Statement filed on February 25, 2004.

The Examiner is further respectfully requested to review and consider and make of record the references cited via the Sixth Supplemental Information Disclosure Statement filed in the U.S. Patent and Trademark Office on October 14, 2005, and the Seventh Supplemental Information Disclosure Statement filed herewith. In this regard, the Examiner is respectfully requested to return an initialed copy(ies) of Form 1449 along with the next communication in this case.

### **CONCLUSION**

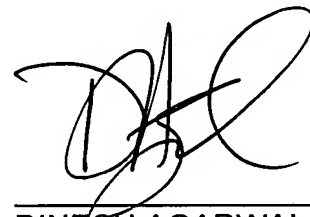
For the foregoing reasons, it is respectfully submitted that Claims 1-5, 7-8, 10-17, 19-32, 34-40, 42-49, 51-61, 63-69, 71-78, 80-88 and 89-100, are all in condition for allowance. Withdrawal of all of the rejections over Christensen ('815), Fuchs (U.S. Patent 6,527,972) and Demon (U.S. Patent 5,813,142), and allowance of these claims are earnestly solicited.

Appl. No.: 10/624,519  
Request for Reconsideration dated February 15, 2006  
Reply to Office Action of August 15, 2005

It is believed that no additional fee is due for this submission. However, should that determination be incorrect, the Commissioner is hereby authorized to charge any deficiencies, or credit any overpayment, to our Deposit Account No. 01-0433, and notify the undersigned in due course.

Should the Examiner have any questions or wish to discuss further this matter, please contact the undersigned at the telephone number provided below.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'D. Agarwal', written over a horizontal line.

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